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Atty. Dkt. No. MRKS/0032.C1

## REMARKS

This is intended as a full and complete response to the Office Action dated September 15, 2005, having a shortened statutory period for response extended one-month set to expire on January 15, 2006.

Claims 1-24, 50-55, 57, 60-61, 70-82, and 94-99 remain pending in the application after entry of this response. Claims 83-93 have been cancelled, and claims 94-99 have been added. Please reconsider the claims pending for reasons presented herein.

### § 102

Claims 1-5, 8-9, 12, 20-24, 50-55, 57, 60-61, and 70-93 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 95/10686 (referred to hereafter as *Lorenz*).

*Lorenz* discloses a positioning apparatus for moving a power tong 110 between an operative and an inoperative position comprises a first arm 102 and a second arm 103. Both arms have an end that is connected to the drilling tower. *Lorenz* does not teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly includes a bearer and the bearer is coupled to a single location of a support member on a drilling tower, as recited in claim 1. *Lorenz* also does not teach, show, or suggest a mounting assembly for coupling the extendable structure to at most one location on a drilling tower, as recited in claim 50. Additionally, *Lorenz* does not teach, show, or suggest a mounting assembly having a bearer adapted to couple the apparatus to a single location on a drilling tower, as recited in claim 70. Further, *Lorenz* does not teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly is adapted to couple the extendable structure to a single location of a support beam disposed above a rig floor, as recited in claim 76. Withdrawal of the rejection is respectfully requested.

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§ 103

Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lorenz* in view of *Swoboda*, U.S. Patent No. 3,840,128.

Claims 6 and 7 depend from claim 1. As discussed above, Applicant believes claim 1 is in condition for allowance. Therefore, Applicant also believes claims 6 and 7 are in condition for allowance. Withdrawal of the rejection is respectfully requested.

Claims 1-5, 8-15, 18-19, 21-24, 50-55, 57, 60-61, and 70-93 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *McArthur*, U.S. Patent No. 4,642,195 in view of *Kelly*, U.S. Patent No. 3,881,375.

Applicant respectfully traverses this rejection. The Federal Circuit recently reemphasized that the U.S. Patent and Trademark Office bears the burden of establishing a case of *prima facie* obviousness. *In Re Dembiczkak*, 50 USPQ2d 1614 (Fed. Cir. 1999). *In Re Dembiczkak* requires the Examiner to *particularly* identify any suggestion, teaching or motivation from within the references to combine the references.

Neither references teach, show, or suggest positioning the apparatus on a drilling tower. *Kelly* discloses an apparatus having a tong assembly T supported on a vertical column having a base support. The tong assembly engages the pipes after the pipe sections have already been stabbed into each other. *Kelly* does not disclose positioning the tong assembly on a drilling tower. In fact, *Kelly* positions the tong assembly above the rig floor using the column, not the drilling tower. *McArthur* discloses a casing stabbing apparatus assembly positioned on a rig floor for engaging a median portion of a suspended casing, and thereafter swing or move the casing to more precisely align the casing over another casing. The stabbing apparatus cannot make up or break out the casings. In fact, the casings are made up in a separate step. (Col. 6, Ins. 52-59). Referring to Figure 1, an operator is shown standing on the rig floor using a wrenching apparatus to make up the casings. Thus, *McArthur* actually teaches away from the combination because it teaches using a wrenching apparatus to make up the tubular instead of the stabbing apparatus. In both *Kelly* and *McArthur*, their respective

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apparatus are position on the rig floor where it would take up space that is limited due to the nature of a rig. Therefore, no motivation or suggestion exists to combine the references. Thus, the Examiner has merely used hindsight based on the Applicant's disclosure to piece together various prior art in order to render the Applicant's claimed invention obvious. The references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly includes a bearer and the bearer is coupled to a single location of a support member on a drilling tower, as recited in claim 1. Also, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly for coupling the extendable structure to at most one location on a drilling tower, as recited in claim 50. Additionally, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly having a bearer adapted to couple the apparatus to a single location on a drilling tower, as recited in claim 70. Further, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly is adapted to couple the extendable structure to a single location of a support beam disposed above a rig floor, as recited in claim 76. Withdrawal of the rejection is respectfully requested.

Claims 6-7, 16-17, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *McArthur* in view of *Kelly* as applied to claims 5 and 15 above, and further in view of *Swoboda*.

Claims 6-7, 16-17, and 20 depend from claim 1. As discussed above, Applicant believes claim 1 is in condition for allowance. Therefore, Applicant also believes claims 6-7, 16-17, and 20 are in condition for allowance. Withdrawal of the rejection is respectfully requested.

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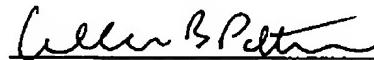
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Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted,



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